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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,523	06/01/2001	H. Robert Horvitz	01997/536002	3312

21559 7590 11/06/2003

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/06/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,523

Applicant(s)

HORVITZ ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 22, 23, 26-28 and 30-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 24, 25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Sequence alignment.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of 33 corresponding to claims 20, 21, 24, 25, 29 drawn to SEQ ID NO:6 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that groups 34-37 are drawn to nucleic acid molecules encoding various mutant LIN-61 polypeptides, which modulates cell proliferation. This is not found persuasive because the nucleic acid molecules in groups 34-37 are not obvious variants of the elected group 33.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-19, 22, 23, 26-28, and 30-60 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

Claims 1-60 are pending and claims 20, 21, 24, 25, and 29 are examined to the extent as they are drawn to SEQ ID NO:6 encoding SEQ ID NO:5.

Claim Objections

Claim 29 is objected to because of the following informalities: the claim does not reflect the election i.e. drawn to multiple inventions. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by NCBI accession number Z71266 (19 April 1996), and Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by NCBI accession number Z71266 (19 April 1996) as evidenced by Kim et al, Genomics. 2003 Nov;82(5):571-4 abstract only, or definition in Stedman's Dictionary downloaded from [url>>pdrel.thomsonhc.com](http://pdrel.thomsonhc.com) on 10-28-2003.

Claim 21 is drawn to a nucleic acid which encodes SEQ ID NO:5; claim 24 is drawn to SEQ ID NO:6 nucleic acid; claim 20 is more broadly drawn to a nucleic acid which encodes a polypeptide comprising at least 130 contiguous amino acids of SEQ ID NO:5 which modulates cell proliferation; claim 25 is more broadly drawn to a nucleic acid which comprises at least 400 contiguous nucleotides of SEQ ID NO:6 and claim 29 is drawn to vector comprising SEQ ID NO:6. NCBI accession number Z71266 (cosmid R06C7) discloses a genomic sequence which encodes SEQ ID NO: 5 and comprises the entire SEQ ID NO:6 with 100 % match, thereby anticipating the instant claims. Note the attached sequence alignment. Although the disclosure does not discuss the properties of the polypeptide encoded by the instant claimed nucleic acid, the claims are drawn to a nucleic acid, not a polypeptide. As for claim 29 drawn to a vector, note that Z71266 is a cosmid, which is a vector according to either Kim et al, Genomics. 2003 Nov;82(5):571-4 abstract only, or definition in Stedman's Dictionary downloaded from [url>>pdrel.thomsonhc.com](http://pdrel.thomsonhc.com) on 10-28-2003.

Conclusion

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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu
October 28, 2003.


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600